

Remarks

Introduction

Claims **1-14 & 18-32** have been canceled.

Claims **15-17 & 33-45** are pending.

Claims **15 & 35** are amended. Claims **16, 33, 34 & 36-45** are not amended.

Claim **17** is rewritten in independent form, but is not substantively amended.

New claims **46-50** are added, dependent on claim **15** and further explain the nature of the inputs. Support for these new claims can be found in paragraphs 0021 & 0022 of the application as originally filed. No new matter is added.

New claims **51 & 52** are added dependent on claims **15 & 35** respectively and clarify the output and the distinction between the first and second player respectively. The total claim count is now twenty-three, with four independent claims. Applicant has previously paid for thirty-six claims and more than four independent claims so no fee should be due.

Applicant amends the specification in three places to correct typographical errors. No new matter is added.

Applicant hereby respectfully requests reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

The Office Action's Rejections

Double Patenting

Claims **15, 16, & 33-45** were rejected on the ground of nonstatutory obviousness-type double patenting in view of U.S. Patent No. 6,361,441. While Applicant has filed a terminal disclaimer in this application signed by an attorney associated with Applicant's customer number, it is the Patent Office's position that the signing attorney is not of record as provided by 37 C.F.R. § 1.34(a). Applicant herein submits a new terminal disclaimer signed by Magdalena Fincham who is of record according to PAIR. Applicant further provides an updated power of attorney listing the undersigned as an attorney of record while eliminating attorneys who have moved out of Applicant's employ.

35 U.S.C. § 102(b)

Claims **15, 35-38 & 42** were rejected under 35 U.S.C. § 102(b) as being anticipated by Piechowiak (hereinafter “Piechowiak”). Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where each and every element of the claim is shown in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

Claim 15 recites:

A method comprising:

receiving a first input from a first player at a first gaming device;

receiving a second input from a second player at a second gaming device;

and

generating, based on both the first input and the second input, a single outcome comprising a plurality of indicia.

Applicant previously argued that the Patent Office did not identify the input from the first player or the input from the second player. The Patent Office clarifies that a first input “includes any game input at game machine such as spin/play or handle pull as conventional for slot/poker machine. . .” (Office Action of January 31, 2007, p. 3, lines 2-3). The Patent Office then goes on to state that Piechowiak teaches “generating, based on both the first and second input, an outcome comprising a plurality of indicia” which includes “the feature controller generates an outcome based on combined results from individual gaming machines towards determining whether a feature is to be enabled (3:5-21). . .” (Office Action of January 31, 2007, p. 3, lines 6-8).

As best understood, the Patent Office’s position seems to be that a first player’s initiation of a first game is the first input; a second player’s initiation of a second game is the second input; and the enablement of a feature based on the combined results from the first game and the second game is the “*generating, based on the first input and the second input, an outcome comprising a plurality of indicia.*” In particular, it is Applicant’s understanding that the “outcome” of the claim is the “enablement of the feature” described by Piechowiak.

Applicant traverses this understanding on two levels.

First, the Patent Office is stretching “*based on both the first input and second input*” past a reasonable interpretation. While it is true that without the initiations of the two game starts, the results of the first game and the second game are not generated such that the feature may not be

enabled, it is clear that this sort of extended “but for” causation analysis is not what was intended by Applicant. Rather, the examples in the specification show that there is a direct basis for generation of the outcome from the inputs rather than this sort of indirect linkage. For example, the specification mentions the selection of a row by a first player and a column by a second player (see paragraph 0021), submission of a seed number (see paragraph 0022), and starting and stopping the reels (see paragraph 00160). All of these examples reflect a direct basis in generation of the outcome from the inputs without an intermediate step of generating a game result, and based on the game results, enabling some other feature as described in Piechowiak. If the Patent Office maintains that the claim language does not state such a direct causation, and finds that attributing such direct causation to the claim is an improper importation of the specification into the claim, Applicant has made this distinction more explicit in new claim **51**.

Applicant notes that the Patent Office’s analysis implicitly acknowledges the lack of direct causation when it states “[t]he occurrences of the predetermined combination of indicia are obtained from gaming results/outcomes that were initiated by player providing input such as start or handle pull selection to their respective gaming machine.” (Office Action of January 31, 2007, p. 7, line 22-p. 8, line 3). As noted by the Patent Office in this statement, the game result is based on the input from the player. Only after the game result is resolved does Piechowiak then enable the feature. Thus, Piechowiak does not teach the enablement of a feature based on the player inputs except in the most general, indirect manner. The Patent Office has construed “based on” overly broadly in its analysis, and has certainly construed the term past what is reasonable to one of ordinary skill in the art based on the specification. MPEP § 2111.01.

Second, Applicant traverses the assertion of the Patent Office that enabling a feature is “*generating . . . an outcome comprising a plurality of indicia*.” Specifically, the feature of Piechowiak is not an outcome comprising a plurality of indicia. Piechowiak describes the feature at col. 1, lines 55-58 as a bonus award, an increased possibility for a winning combination, or any other feature which alters the normal operation of the gaming machines. But nowhere in the reference has Applicant been able to find any teaching or suggestion that the feature is a plurality of indicia. Since the Patent Office has equated the feature with Applicant’s claimed outcome, and the feature does not comprise a plurality of indicia as recited in claim **15**, Piechowiak does not anticipate claim **15**.

In the ***Response to Arguments*** section (and in particular at page 8, lines 5-8), the Patent Office has some language which appears to provide a possible alternate interpretation of what is being construed to be Applicant's recited "outcome". If Applicant's analysis above has misunderstood the Patent Office's analysis, Applicant requests clarification as to what precisely is the "outcome" of the claim. However, in the interests of responding to this possible alternate interpretation, Applicant proceeds.

For this possible alternate interpretation, the Patent Office appears to be engaged in a box drawing exercise. In particular, the Patent Office states that Applicant's outcome does not preclude other outcomes. By stating that the "outcome" of claim does not preclude more than one outcome, the Patent Office is erasing the box that Applicant has drawn (albeit through examples and not specific definitions) around a single outcome in the specification, and drawn the box around the plurality of outcomes from the different machines. This interpretation (if, in fact, this is the interpretation intended by the Patent Office) stretches the claim language past what someone of ordinary skill in the art would consider reasonable when considered in light of the specification. Certainly, none of the examples provided in the specification would support such a differently drawn box. Applicant has amended claim **15** to recite that the outcome is a single outcome to forestall this possible interpretation.

Claim **38** depends from claim **15** and is allowable at least for the same reasons that claim **15** is allowable.

Claim **35** recites "*outputting on the display device an indication of the outcome obtained by the first player.*" Applicant previously argued that this element was not taught. In its ***Response to Arguments*** section, the Patent Office further explains its position while asking for clarification. In particular, the Examiner inquires whether the Applicant believes Piechowiak does not require player input or permits automated play. Applicant does not see how this inquiry is relevant to the question of whether Piechowiak outputs on the display device of the second device an indication of the outcome obtained by the first player as recited in the claim.

The Patent Office then states that the first and second players are not defined to be different players and that it is conceivable that the first player and the second player can be the same individual playing at separate gaming devices (Office Action of January 31, 2007, p.8, line 19 to p. 9, line 1). Applicant finds that this position strains credibility and stretches the claim language beyond what someone of ordinary skill in the art would consider reasonable when

interpreted in light of the specification. While Applicant maintains that the Patent Office has overly broadly construed the claim language on this point, Applicant provides new claim **53**, which makes the distinction between the first player and the second player explicit.

The Patent Office then states that the gaming devices could be the same device (Office Action of January 31, 2007, p.9, lines 1-2). Again, Applicant finds that this assertion strains credibility and is inconsistent with the broadest interpretation that would be given by someone of ordinary skill in the art in light of the specification. Applicant has amended claim **35** to recite that the second device is not the first device to make this distinction explicit.

The Patent Office then states that Piechowiak teaches outputting the on the display an indication of the outcome on the display (Office Action of January 31, 2007, p. 9, lines 3-5). In particular, the Patent Office points to element 213 wherein the feature is displayed. Applicant notes that the corresponding text does not support the Patent Office's interpretation. Specifically, the feature is displayed on display 128 (see Piechowiak, col. 3, lines 22-27), which is not a device on which the game is played. Rather, display 128 is, as readily shown in Figure 1, distinct from the gaming devices and is more akin to an attract screen that is used in conjunction with a bank of machines. See also, col. 2, lines 11-21 which describe gaming machines 101-108 compared to col. 2, lines 36-44, which describes the output display 128. Clearly, output display 128 is not part of the gaming machine, nor would it be construed to be the display device of the second device as recited in claim **35**.

Claims **36, 37 & 42** depend from claim **35** and are not anticipated at least for the same reasons.

Applicant notes that the Patent Office admits that "it is not clear whether an association exists between players playing at linked machines" in its discussion of Piechowiak (Office Action of January 31, 2007, p. 5, lines 1-2). This admission vitiates the Patent Office's position that Piechowiak anticipates claims **38 & 42**.

Applicant requests withdrawal of the § 102(b) rejection of claims **15, 35-38 & 42** at this time.

35 U.S.C. § 103

Claims **38 & 42** were rejected under 35 U.S.C. § 103 as being unpatentable over Piechowiak in view of Celona (hereinafter "Celona"). Applicant respectfully traverses. For the

Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught. MPEP § 2143.03. If the Patent Office cannot establish *prima facie* obviousness, Applicant is entitled to a patent. 35 U.S.C. §§ 102 & 103.

Applicant initially notes that the addition of Celona does not cure the underlying deficiencies of Piechowiak. That is, Celona does not teach the outcome, based on the first and second inputs, comprising a plurality of indicia (claim **15** from which claim **38** depends), nor does Celona teach “*outputting on the display device an indication of the outcome obtained by the first player. . . .*” (claim **35** from which claim **42** depends). Thus, since neither reference individually teaches the claim element, the combination of references cannot teach the claim element, and the combination does not establish *prima facie* obviousness.

Further, before the Patent Office can combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir. 1999). In the present application, the Patent Office states that the motivation to combine the references is “to increase interest in gaming at linked gaming machines.” (Office Action of January 31, 2007, p. 5, line 10). Applicant initially notes that this motivation lacks the actual evidence required by the Federal Circuit. As such, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection does not establish obviousness. Even if the motivation had been properly supported, the motivation does not compel the combination. Rather, someone seeking to have associated players in linked gaming machines would implement Celona alone and not look to Piechowiak for additional material. Since the motivation does not compel the combination, the combination is improper, and the Patent Office has not established obviousness.

Claims **38-45** were rejected under 35 U.S.C. § 103 as being unpatentable over Piechowiak in view of Marks et al. (hereinafter “Marks”) or Guinn et al. (hereinafter “Guinn”) or Thacher et al. (hereinafter “Thacher”). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

Applicant initially traverses this rejection because the Patent Office has not shown the element missing from Piechowiak. As explained above, Piechowiak does not teach an element in claim **15** and does not teach an element in claim **35**. The Patent Office has not explained how the additional references teach the element missing from Piechowiak. Thus, even in

combination, the Patent Office has not shown an element from each of the independent claims. Since the Patent Office has not shown an element, the Patent Office has not established *prima facie* obviousness.

Applicant further traverses the rejection since the Patent Office has not provided the proper support to combine the references. As noted above, the Patent Office must show actual evidence to support the motivation to combine the references. The Patent Office's asserted motivation to combine the references is "to increase interest in linked progressive play thereby which increases revenue due to increased play." (Office Action of January 31, 2007, p. 6, lines 11-12). This asserted motivation lacks the required evidence required by the Federal Circuit. As such, the motivation is improper. Since the motivation is improper, the combination is improper, and the Patent Office has not established *prima facie* obviousness.

Applicant still further traverses the rejection because the references do not teach the recited claim elements. The Patent Office acknowledges that Marks, Guinn, and Thacher do not teach the details of the claims (Office Action of January 31, 2007, p. 5, lines 20-21). This admission is fatal to the Patent Office's obviousness rejection. If the reference does not teach the specific claim element, then the Patent Office has not established obviousness. MPEP § 2143.03. Merely because team play is known, specific elements within the claims are not taught or suggested. For example, claims **41 & 45** deserve special mention in that they recite "*detecting a representation from the players that they are on the team together.*" While the Patent Office asserts that these elements are so well known as to have been omitted from the references, such analysis is fine for a patent drafter, but insufficient for the Patent Office to sustain its burden in proving obviousness. If these elements are well known, then the Patent Office should have been able to find a reference prior to Marks, Guinn, and Thacher that explicitly teaches these concepts for team play and used that reference instead. In the absence of such a teaching, the Patent Office has not met its burden in establishing obviousness. MPEP § 2143.03.

Since the Patent Office has not established *prima facie* obviousness, Applicant requests withdrawal of the § 103 rejection of claims **38-45** at this time.

Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Taylor M. Davenport at telephone number 203-461-7228 or via electronic mail at tdavenport@walkerdigital.com, at the Examiner's convenience.

Authorization to Charge Fees

Applicant does not believe an extension of time to make this Amendment and Response timely is necessary. However, should an extension of time be necessary, please grant a petition of an extension of time necessary to make this submission timely. Applicant authorizes that \$130.00 be charged to deposit account 50-0271 to pay for the fee associated with the terminal disclaimer. Additionally, please charge any fees that may be required for this submission as follows:

Deposit Account: 50-0271

Order No. 03-068

Charge any additional fees or credit any overpayment to the same account.

Respectfully submitted,

March 30, 2007
Date

/Taylor M. Davenport Reg. #42,466/
Taylor M. Davenport
Attorney for Applicant
Registration No. 42,466
Walker Digital, LLC
tdavenport@walkerdigital.com
203-461-7228/voice
203-461-7300/fax